

REMARKS

Reconsideration of the present application is requested on the basis of the following particulars.

1. Interview of February 25, 2004

Applicant appreciates the courtesy of the Examiner in granting an interview with Applicant's representative on February 25, 2004. In accordance with the discussion at the interview, Applicant has amended the claims and presents commentary discussing the distinguishing characteristics of the present invention over the cited prior art in view of the claim amendments.

2. Amendment of Claims

Claims 1-15 are currently presented as being amended in the List of Current Claims.

As will be discussed in more detail below in reference to the rejection of claims 1-15 under 35 U.S.C. § 112, first paragraph, the term "non-utilitarian" has been removed from the claims.

Claim 1 has been amended to recite the main plate as having first and second surfaces. This is clearly described in the drawings of the present application as originally filed. Next, the insert plate is presently recited as being snugly disposed within the boundary of the main plate. This feature is likewise clearly presented in the drawings as originally filed and in paragraph [0011] in the specification. While both of these amendments have been provided to more clearly recite the subject matter of claim 1, Applicant maintains that the substance of these amendments is inherent in claim 1 as originally filed.

Claim 1 has also been amended to recite that the backing member is configured for placement on a structural surface and includes at least one adhesive

element on a surface opposite a surface upon which the main plate is mounted. Support for this feature of amended claim 1 is found in paragraph [0013].

Claims 2, 3 and 14 have been amended to parallel the amendment to claim 1.

Applicant respectfully request acceptance of the amendments to claims 1-15 in the next communication concerning the above-application.

3. Rejection of Claims 1-15 Under 35 U.S.C. § 112, First Paragraph

Claims 1-15 presently stand rejected as failing to comply with the written description. It will be noted that the term "non-utilitarian" has been removed from the claims. It should be pointed out that in accordance with the description of the term "decorative" in Webster's Third New International Dictionary – Unabridged Edition, "decorative" means that something has "purely ornamental function." Moreover, the term decorative is also used in the following exemplary phrase: "its buildings were utilitarian rather than decorative." In view of the definition of "decorative" and its use in the exemplary phrase, Applicant maintains that the description "non-utilitarian" is inherent in the ordinary dictionary meaning of "decorative."

The specification and abstract ha been amended by the removal of the term "non-utilitarian" added therein in the amendment of July 14, 2003.

Accordingly, it is respectfully submitted that claims 1-15 comply with 35 U.S.C. § 112, first paragraph. Withdrawal of the rejection is requested.

4. Rejection of Claims 1-15 Under 35 U.S.C. § 102(b) As Being Anticipated by U.S. Patent 5,529,742 (Strapazzini)

Claims 1-15 presently stand rejected as being anticipated by the disclosure of Strapazzini. As discussed at the interview and in view of the amendment to claims 1-15 detailed above, Applicant respectfully traverses this rejection.

As noted during the course of the interview, the disclosure of Strapazzini relates to a method of forming a panel for use as a door panel of a vehicle. As shown in FIGS. 9-18 in the disclosure of Strapazzini, sheet 18 incorporates inserts 11 and 12, and is subjected to a molding process that includes the molding of substrate 40 into the sheet 18. In the Action, the sheet 18 used in the method of Strapazzini has been equated with the main plate recited in the claims of the present application. Contrary to the disclosure of the Strapazzini, the claims of the present application are directed to providing an overlay member for a door panel that is already formed.

To make the claims of the present application clearer in their recitation of the overlay trim member recited therein, it has been made clear in the amendment of claim 1 that the backing member of the overlay trim member is configured for placement on a structural surface. Moreover, the backing member is recited as comprising at least one adhesive element on a surface opposite a surface upon which the main plate is mounted.

It is respectfully submitted that the disclosure of Strapazinni does not disclose a method for forming an overlay trim member, as described in the present application and recited in the accompanying claims. As a result, Strapazinni fails to disclose or suggest each and every feature recited in claim 1. Thus, claim 1 is patentable. Claims 2-15, which depend directly or indirectly from claim 1, are thus patentable based on their dependency from claim 1 and their individually recited features. Accordingly, withdrawal of this rejection is respectfully requested.

5. Rejection of claims 1-4, 7-8 and 11-15 under 35 U.S.C. § 102(b) As Being Anticipated by U.S. Patent 3,423,276 (Eckenroth)

Claims 1-4, 7-8 and 11-15 presently stand rejected as being anticipated by the disclosure of Eckenroth. As discussed at the interview and in view of the amendment to claims 1-4, 7-8 and 11-15 detailed above, Applicant respectfully

traverses this rejection.

As noted at the interview, claim 1 of the present application has been amended to make it clearer that the insert member is snugly disposed within the boundary of the opening of the main plate. On the contrary, the disclosure of Eckenroth describes a decorative covering having openings that constitute access holes cut through decorative and reinforcing sheets. The access holes are configured to fit closely around instruments on a conventional dashboard panel including mountings for a speedometer, clock, radio, and ignition switch (col. 1, lines 62-67). Of particular note, while the dashboard mountings in the disclosure of Eckenroth extend through the access holes of the reinforcing sheet, such dashboard mountings do not fit snugly within the boundaries of the access holes since the dashboard mountings are mounted onto the dashboard panel 12.

While the instrument mountings in Eckenroth obviously provide utilitarian functionality, they are not provided for decorative purposes as are the insert plates of the present invention. Instead, the access holes in Eckenroth are arranged and configured so as to accommodate the instrument mountings and are limited in size and shape only to such instrument mountings. Accordingly, the access holes described in Eckenroth are not arranged simply for decorative reasons, and therefore, are not arranged to receive decorative insert plates in the manner recited in claim 1 of the present application.

Accordingly, it is respectfully submitted that the disclosure of Eckenroth fails to disclose or suggest an overlay trim member of the present application. Withdrawal of the rejection is respectfully requested.

6. Rejection of claims 5 and 9 under 35 U.S.C. § 103(b) As Being Unpatentable over U.S. Patent 3,423,276 (Eckenroth) In View of U.S. Patent 5,247,018 (Maeda et al.)

Claims 5 and 9 stand rejected as being unpatentable over Eckenroth in view

of Maeda et al. It is submitted that Maeda et al. fails to make up for the basic shortcomings of Eckenroth, as discussed above. More particularly, Maeda et al. fails to disclose or suggest an overlay trim member having a decorative main plate with at least one opening and at least one decorative insert plate configured to be snugly disposed in the boundary of the at least one opening.

Accordingly, it is respectfully submitted that Eckenroth and Maeda et al., whether considered collectively or independently, fail to disclose or suggest the overlay trim member of the present application, as recited in claim 1. Claims 5 and 9, which directly or indirectly depend from claim 1, are likewise patentable based on their dependency from claim 1 and their individually recited elements.

7. Conclusion

In view of the amendments to the claims, and further in view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is respectfully requested that claims 1-15 be allowed and the application be passed to issue.

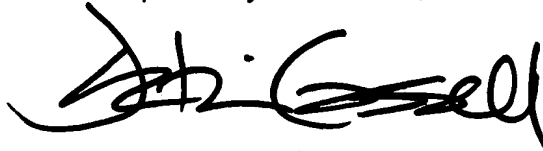
If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's Attorney, the Examiner is invited to contact the undersigned at the numbers shown below.

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amendment 160304.wpd

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Justin J. CasSELL", with a stylized flourish at the end.

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